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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/233,145	01/19/99	YAMAZAKI S	0756-1915

MM42/0625

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EXAMINER	
DUONG, T	
ART UNIT	**PAPER NUMBER**
2871	2

DATE MAILED: 06/25/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/233,145	YAMAZAKI ET AL
Examiner	**Group Art Unit**
T. DUONG	2871

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

P ri d for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disp sition of Claims

☒ Claim(s) 1-30 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-30 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☒ received in Application No. (Series Code/Serial Number) 07/897,669.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachm nt(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of References Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. Claims 1-30 recite subject matter that was originally disclosed in the parent application (07/897,669) but not recited in the original claims. A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

The Abstract and the Brief Summary of The Invention are to be modified for being commensurate with the claimed invention.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 19, 21, 25 and 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 22 of U.S. Patent No. 5,612,799 in view of JP No. 1-156725 (JP'725) and Sasaki et al'905 . Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the claims of this application and that of the patent claim is the pixel being connected directly to the

semiconductor. Claims 19, 21, 25 and 26 would have been obvious for the same reasons set forth in the Office action dated 3/18/98 (Paper No.15) of the parent application 08/566,897.

Claims 1-5, 7-11, 13-17, 19-23 and 25-29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27, 29-33, 35-37 and 51-53 of copending Application No. 08/566,897. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only differences are the preamble and the deletion of the phrase " comprising a transparent conductive oxide ". Such differences would have been obvious to a person of ordinary skill in the art if the transmissive type of the display device is not desired or critical, e.g. reflective display device. It is noted that the instant claims are broader in scope than those of the parent application 08/566,897.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 6, 12, 18, 24 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what the recited feature " digital display " means or refers to. Does the digital display refer to "digital gradation display " ?.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamazaki et al'799 in view of JP'725 and Sasaki et al '905. Since the instant claims are similar to claims 27, 29-33, 35-37 and 51-53 of the parent application 08/566,897, claims 1-5, 7-11, 13-17, 19-23 and 25-29 are rejected for the same reasons set forth in the Office action dated 3/18/98 (Paper No.15)

of the '897 parent application. Regarding claims 6, 12, 18, 24 and 30 , see col. 16, lines 2-6, of Yamazaki et al'799.

Any inquiry concerning this communication should be directed to Tai Duong at telephone number (703) 308-4873.

TD
TVD

June 21, 1999

William L Sikes

WILLIAM L. SIKES
SUPERVISORY PATENT EXAMINER
GROUP 2500